

the art that Figure 1 represents a client/server computer network, since Figure 1 clearly shows and labels several client computing systems in communications with several server computing systems. Adding the label suggested by the examiner lends nothing to the understanding of the drawing.

In another example, element 34 of Figure 2 is simply a system. Labeling element 34 as a “system” does not provide any better understanding of the drawing. It is clear that Figure 2 is a computing system to one skilled in the art, since all of the elements of the “system” are clearly labeled. Furthermore, providing many of the other labels suggested by the Examiner, for example, the links in Figure 5, would unduly clutter the figure and providing the word “link” or “pointer” next to each number would not add anymore understanding to the drawings.

Each Figure is clearly described in the Brief Description of the Drawings section of the specification, which is a legend of the drawings. 37 CFR 1.84 (o) does not state “without substantial analysis of the detailed specification” as the Examiner has described.

In view of the above, Applicants respectfully request the Examiner to withdraw the objection, or provide a detailed explanation of specifically which labels the Examiner will require.

#### Claim Rejections – 35 USC § 102

The Examiner rejected claims 1, 3, 4, 7, and 9 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,663,736 (the '736 patent) issued to *Furusawa et al.* The Examiner points to the specification in Col. 3, Lines 27-43 to show a first flag being set; and the

Abstract, lines 1-14 to show a second flag being set. Applicants respectfully traverse this rejection.

A careful reading of the '736 patent reveals that Col. 3, Lines 27-43 and the Abstract, Lines 1-14 both refer to a single set/reset code. In fact, the entire specification and drawings refer to a single set/reset code having a value of "\*" or a value of a space. The value of a space indicates messages to be deleted, while the value of "\*" indicates message not to be deleted. The Abstract, Lines 1-14, discusses this same set/reset code as does Col. 3, Lines 27-43. The entire method of deleting a message disclosed in the '736 patent is found in Col. 4, Lines 3-7 and Lines 17-20. "Next, the operator depresses the deletion set/reset key (DEL) 7a, then, the deletion function 12 changes the set/reset code at the top of the fourth line from (\*) to the space which indicates that the message is to be deleted." Col. 4, Lines 3-7. "Next, the operator depresses the execution key 11, then, the execution function 14 executes the deletion of the messages which have the space code at the set/reset code location." The '736 patent does **not** disclose or teach a second flag.

In contrast, claim 1 of the present invention specifically includes a first and a second flag and deletes "messages contained in folders having the second flag marked and the first flag unmarked." Two separate conditions must be met in the present invention prior to deleting messages contained within a folder.

✓ Furthermore, the '736 patent does not teach or disclose marking folders with flags. The entire '736 patent discloses marking individual messages with a single code. In contrast, claim 1 of the present invention includes "marking folders" with flags.

For at least the reasons discussed above, claim 1 is patentable over the '736 patent. Because claims 2-11 depend from allowable claim 1, they are likewise patentable over the '736 patent.

#### Claim Rejections - 35 USC § 103

The Examiner makes several 103 rejections in the Office Action. For each 103 rejection, Applicants do not believe the Examiner has established a *prima facie* case for obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met, namely: 1) suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings; 2) a reasonable expectation of success; and 3) the references, when combined must teach or suggest all the claim limitations. See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143 *et seq.*

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure. Id. The mere fact that the references ~~can~~ be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP § 2143.01. A prior art reference must be considered in its entirety, including portions that lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983).

Applicants believe the Examiner has failed to establish any of the factors listed above for a *prima facie* case of obviousness for each of the Examiner's 103 rejections. As such, applicants

respectfully request that the Examiner establish a *prima facie* case of obviousness for each of the Examiner's suggested combinations or withdrawal of the rejections. In view of the above arguments, pending claims 1-38 are in condition for allowance.

The Examiner rejected claims 2, 5, 6, 8, and 10 under 35 U.S.C. 103(a) as being unpatentable over the '736 patent and in view of U.S. Patent Number 6,401,239 (the '239 patent) issued to *Miron*.

As discussed above, the '736 patent fails to disclose the use of two flags. The Examiner has not pointed to anywhere in the '239 patent that discloses the use of two flags either. Claims 2, 5, 6, 8, and 10 include all the limitations of claim 1 discussed above. Therefore, the 103(a) rejection is improper and moot in light of the arguments presented above in connection with the 102 rejection. In addition, claims 2, 5, 6, 8, and 10 depend from allowable claim 1. As such, claims 2, 5, 6, 8, and 10 are allowable over the '736 and the '239 patent for at least the reasons provided above.

The Examiner rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over the '736 patent and in view of U.S. Patent Number 6,330,573 (the '573 patent) issued to *Salisbury*.

As discussed above, the '736 patent fails to disclose the use of two flags. The Examiner has not pointed to anywhere in the '573 patent that discloses the use of two flags either. Claim 11 includes all the limitations of claim 1 discussed above. Therefore, the 103(a) rejection is improper and moot. In addition, claim 11 depends from allowable claim 1. As such, claim 11 is allowable over the '736 and the '573 patent for at least the reasons provided above.

The Examiner rejected claims 12-14, 16-22, 24-29, and 31-34 under 35 U.S.C. 103(a) as being unpatentable over the '736 patent and U.S. Patent Number 6,154,764 (the '764 patent) issued to *Miron*.

As discussed above, the '736 patent fails to disclose the use of two flags. The Examiner has not pointed to anywhere in the '764 patent that discloses the use of two flags either. Furthermore, the '764 patent does not even disclose one of the flags discussed in claim 12. The '764 patent discloses the use of "lock information" that "indicates whether the posted message is accessible to users...." Col. 5, Lines 35-64. This is not an off-line flag as required in claim 12. Claim 12 requires "indicating folders containing messages to be retained with an off-line flag...." The lock information of the '764 patent has absolutely nothing to do with retaining folders; the lock information merely enables or disables access to an email by another user.

In addition, the '764 patent does not disclose marking folders, but instead with locking messages. The '736 patent does not disclose marking folders either. For at least these reasons, claim 12 is allowable over the '736 patent and the '764 patent. Claims 20 and 27 contain similar limitations to that of claim 12 and thus are allowable over the '736 patent and the '764 patent as well. Claims 13-19 depend from allowable claim 12, claims 21-26 depend from allowable claim 20, and claims 28-34 depend from allowable claim 27, and thus claims 13-19, 21-26, 28-34 are allowable over the '736 patent and the '764 patent as well.

Conclusion

In view of the above, it is submitted that all claims are in condition for allowance.


Applicants request reconsideration, withdrawal of the rejections, and a Notice of Allowance.

If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,

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